

### REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars:

#### Rejection of claims 1-3 and 18 under 35 U.S.C. § 112, first and second paragraph

In the previous Office action, mailed on October 12, 2006, claims 1-3 and 18 were rejected as failing to comply with the enablement requirement and as failing to set forth the subject matter which the applicant(s) regard as their invention. No other rejections were set forth in that Office action. In a response to the Office action of October 12, 2006, Applicant submitted remarks traversing these rejections.

Applicant notes that, although these rejections under 35 U.S.C. § 112 are not included in the presently outstanding Office action, mailed on April 20, 2007, the examiner has stated that “the Examiner has reviewed the Applicant’s response and does not find the related arguments to be persuasive.” Because the recent Office action makes no reference to these rejections under 35 U.S.C. § 112, it is not clear if the claims remain rejected on these grounds. However, to the extent that the claims remain rejected under the first and second paragraphs of 35 U.S.C. § 112, Applicant again respectfully traverses these rejections as follows.

#### Rejection under 35 U.S.C. § 112, first paragraph

Applicant respectfully submits that claims 1-3 and 18 comply with the enablement requirement, and that the examiner has failed to state a prima facie case of non-enablement.

Applicant responded to the rejection under 35 U.S.C. § 112, first paragraph, in Applicant’s response dated January 12, 2007. In that response, Applicant noted that the examiner had asserted that the specification does not appear to support “a process wherein a caller or a user of a cell phone (call originator) places a call to a receiver or called party via a telecommunication service (service provider) or data processing entity, which agrees to charge a price, consisting of an operational cost (standard cost) and an action-specific

amount, to the call originator and wherein the action-specific amount is donated or forwarded to the receiver of the incoming call.” More particularly, the examiner asserted that the specification does not show how a call originator places a call to a call recipient and the call recipient receives an action-specific amount charged to the caller or call originator.

In that response, Applicant sought to explain how this is supported and enabled by pointing out that the placement of the call, and the transfer of funds to the call receiver is shown in Fig. 2, and the related discussion at line 28 of page 7 through line 20 of page 8. Step 22.1 of the process illustrated by the flow chart of Fig. 2 indicates transfer by the data processing entity of the action-specific amount to the receiver.

Further, Applicant referred the examiner to the first paragraph of page 7 which states, in reference to Fig. 1, that a data processing entity can be either a telecommunication company, a financial institution, a lottery company, or an institution related to the fundraising, which is connected to the giver by a link representing the flow of a debit order from the giver to the collecting data processing entity of both the action-specific and operational cost amounts. The second paragraph of page 7, again referring to Fig. 1, states that a receiver is connected to the data processing entity by a signal representing the flow of a credit order from the raised funds (i.e., the amount of the debit order less operational costs) from the data processing entity.

Thus, the present specification clearly teaches an embodiment of the present invention wherein transfers of funds between parties are made by credit or debit orders. It is respectfully submitted that such credit and debit orders, electronic transfers of credit and debit orders, and other means of transferring money or funds between parties are well known.

In the recent Office action, in responding to Applicant’s arguments set out in the January 12, 2007 response, the examiner states that “the Applicant describes, on page 12 of the [January 12, 2007] response, a credit and debit scenario, which does not address the Examiner’s concern.” However, the examiner has not indicated why the explanation of the transfers of funds according to the credit or debit orders does not address the

examiner's concerns relating to how a call receiver receives an action-specific amount charged to the call originator.

As pointed out in the last paragraph of page 2, continuing onto page 3, of the original specification, a user of a telephone will receive an invoice (or a charge automatically applied to a credit card or the like) for both the use and the duration of a telephone call and the operational cost related to it. The operational cost is increased with a certain amount that the user is willing to be charged. In other words, the user of the telephone will be charged, for calls to a specific receiver according to the claimed invention, a first amount which represents simply the basic service cost for the telephone call, and a second amount which is the action-specific amount that is paid to the call receiver.

It is respectfully submitted that generating an invoice (or a charge against a credit card or other means for automatic payment) to a telephone user is well known among persons skilled in the art. Further, it is respectfully submitted that electronic transfers of credit and debit orders, as illustrated in one embodiment to forward an action-specific amount to the call receiver, are well known to persons skilled in the art as are other means of transferring money or funds between parties.

Regarding the examiner's statement in the Office action of October 12, 2006 that "there is no incentive for providing the action-specific amount to the receiver for accepting the incoming phone call from the caller/call originator," Applicant again respectfully submits that the *incentive* for providing an action-specific amount to a receiver for accepting the incoming call is not relevant to the question of enablement.

However, Applicant submits that an incentive to cause a payment to be made to a call receiver, simply by placing a telephone call, is quite clear *especially* when the call receiver is a charity. For example, Applicant would respectfully submit that the incentive to make a donation to a charity by simply placing a telephone call, with the knowledge that placing the telephone call will automatically cause a payment to be made to the charity and will add a charge to the caller's telephone bill for the amount donated, requires no explanation.

Applicant respectfully submits that in most cultures, contribution, and especially to charitable causes, is typically socially important, whether the donation is made publicly or in private. In certain cultures, contributions or donations may be done in public, helping to define one's social image within the community. In other cultures, to donate is rather a private matter, where money may be given, for example, in the hope of having paid for one's remorse. In either situation, it is respectfully submitted that the incentive for providing an action-specific amount (for example a donation) to a call receiver (for example a charitable organization) is quite clear without further explanation.

Thus, according to the present invention, a donation is made, by a party wishing to donate to a given organization, by placing a telephone call to the specific telephone number assigned (by the data processing facility) to the organization requesting donations from members of the general public.

This request for a donation could be launched via any media (radio, television, press, billboards, leaflets, Internet, hearsay, etc) and would explicitly mention the telephone number assigned to this organization, and the "cost" of the call (i.e. the amount that will be charged to the call originator). Accordingly, the telephone number may be as recognizable to the general public, due to such advertisement, as an e-mail address, website address, or other publicly known identifiers of these organizations.

The donation is made by simply making a telephone call to the specific telephone number assigned to this organization, and - once the connection is established (thanks to which the call originator is recognized by the data processing facility - see Claim 18) - to disconnect, or hang up [Claims 1-3], so that, according to the terms of the agreement between the organization and the data processing facility, the data processing facility will transfer to the organization the agreed upon part of the amount charged by the data processing facility to the caller.

Consequently, the donation from the donator cannot be undone. It is not a pledge that needs to be later confirmed by the donator (such as a pledge of a caller into a "telethon" or similar fundraiser), nor does the donator have to communicate his bank account or credit card information to the organization to finalize his donation.

For at least these reasons, withdrawal of this rejection is requested.

Rejection under 35 U.S.C. § 112, second paragraph

Applicant respectfully submits that claims 1-3 and 18 comply with the requirements of 35 U.S.C. § 112, second paragraph.

In particular, the examiner states that “although claim 1 recites in the preamble a ‘method of raising funds by using existing communication means’, however, the body of the claim never explicitly refers back to any ‘fund raising method’.”

Applicant responded, in Applicant’s response dated January 12, 2007, by amending claim 1 amended to recite that the amount is “forwarded by said data processing entity to said receiver if the incoming call *whereby funds are raised by said receiver.*”

Applicant notes that “raising funds” simply refers to acquiring funds, i.e. money or another representation of monetary or other value. It is respectfully submitted that persons skilled in the art would readily recognize that funds are raised by the receiver since claim 1 specifically points out that a portion of an amount charged to the originator of a call is forwarded by the data processing entity to the receiver of the call, and as amended claim 1 clarifies that the recited method results in funds raised by the receiver.

In the recent Office action, the examiner contends that “raising funds” is not equivalent to “acquiring funds.” Applicant disagrees with the examiner’s distinction between “raising funds” and “acquiring funds.” However, in the interest of expediting prosecution of the present application, Applicant has amended claim 1 to recite “a method for acquiring funds [...] whereby funds are acquired by said receiver.”

In view of the amendment to claim 1, withdrawal of the rejection is requested.

The examiner’s general comments

In the recent Office action, the Examiner states that, to his understanding, “the originator of the phone call or the caller plays no role in directly contributing any monetary value to the receiver’s fundraising activities since the agreement is between the data processing facility and the receiver.”

However, Applicant notes that it is by a choice of the originator of the phone call to which telephone number he or she will place the call, and that the choice is made according to the caller's 1) decision to make a donation; and 2) the caller's preference as to who should receive the donation. The caller knows that, by placing the call, he knowingly gives approval to charge the call to his account, including the donation amount. In other words, the initiative lies in the hands of the caller.

The Applicant's claimed invention just gives the opportunity to any donator to make an impulsive donation, as it is not necessary to be connected to a network in order to make a contribution, nor to be present at a contribution session. The only thing the donator needs to know is the telephone number corresponding to the organization to which he wants to donate.

Rejection of claims 1-3 and 18 under 35 U.S.C. § 103(a)

Claims 1-3 and 18 presently stand rejected as being unpatentable over Ziarno (U.S. 2001/0001855). This rejection is respectfully traversed for at least the following reasons.

Applicant notes that claims 1-3 were previously rejected as unpatentable over Ziarno, in an Office action mailed on April 10, 2006. Applicant traversed this rejection in Applicant's response filed on July 10, 2006, and this rejection appears to have been **withdrawn** in the subsequent Office action dated October 12, 2006 since the rejection in view of Ziarno was not repeated, and the examiner stated that "Applicant's arguments [directed to the rejection in view of Ziarno] with respect to the claimed invention have been considered, but are **moot in view of the new ground(s)** of rejection."

Applicant notes that much of the present rejection over Ziarno simply repeats the language of the rejection set forth in the April 10, 2006 Office action. In the present Office action, the examiner has added a discussion, at pages 5 and 6 of the present Office action, directed to what the examiner contends is common practice in the industry, or is well known in the art, although the examiner does not cited any reference or other evidence in support of these contentions.

Claim 1 is presently amended to recite *generating* an operational fixed or wireless telephone or similar telecommunication connection connecting an incoming call from a telecommunication device used by an originator through the services of a selected data processing entity with a specific receiver, *and once said connection is generated, disconnecting said connection*, wherein it has been agreed with said data processing entity that an amount charged to the originator of the incoming call *upon disconnecting said connection* comprises a part representing the operational costs of said data processing entity and another part representing an action-specific amount to be forwarded by said data processing entity to said receiver of the incoming call, whereby funds are acquired by said receiver. Support is found at least in lines 7-14 of the original specification.

The examiner cites Ziarno as disclosing a method of and a system for conducting a fundraising over a computer network, such as the Internet. While the examiner provides a discussion of Ziarno's method and system, the examiner has failed to identify how any aspect of Ziarno provides any teaching or suggestion of the present invention, beyond the broadest possible notion of fundraising.

It is respectfully submitted that Ziarno (along with the examiner's "Official Notice") fails to disclose or suggest each and every element set forth in claim 1 of the present application.

More particularly, it is respectfully submitted that Ziarno does not disclose or suggest generating an operational telephone or similar telecommunication connection connecting an incoming call with a specific receiver, and once said connection is generated, disconnecting said connection, wherein it has been agreed with said data processing entity that an amount charged to the originator of the incoming call upon disconnecting said connection comprises a part representing operational costs and another part representing an action-specific amount to be forwarded to the receiver of the incoming call.

While Ziarno discloses the interconnection of plural computers through a computer network, Ziarno fails to disclose or suggest a fixed wireless telephone or similar telecommunication connection. Further, Ziarno does not disclose or suggest that an

amount charged to the originator of a call upon disconnecting the call connection comprises a part representing the operational costs and another part representing an action-specific amount to be forwarded to the receiver of the incoming call.

The examiner recognizes these shortcomings of Ziarno (page 5 of the recent Office action), noting that “as per claims 1-3 and 18, Ziarno does not disclose a system, wherein a contributor or donor uses a telephone set, instead of or in addition to a computer, to participate in the fund-raising activities, wherein a portion of the price charged to the contributor when making a phone call to a third party or call receiver, including a charitable organization, is donated to the third party or receiver.”

It necessarily follows that Ziarno does not disclose or suggest connection and subsequent disconnection of the telephone connection, or that an amount is charged to the originator of the incoming call *upon disconnecting the connection*.

The examiner takes Official Notice of the use of telephones in fund-raising activity, citing for example “a Public Broadcasting Station (PBS) such as a television station, [which] usually conducts an annual fund-raising by soliciting the making of monetary donations from its viewers, who use their telephones to respond by donating a specific monetary value set by the station or a value of their choosing.”

Such fund-raising drives, however, are often characterized as discussed in Ziarno, wherein “a contributor is requested to make a pledge, *and then later* to honor the pledge by payment of the amount pledged.” (*Ziarno*; [0002]). In other words, a caller often uses the telephone to make a pledge, whereafter the PBS (or other fund-raising organization) later sends a reminder of the pledge to the caller, and the caller subsequently submits (by check, cash, credit card, or the like) payment of the pledged amount.

Of course, credit card payments may be accepted over the telephone, according to a typical process wherein the caller gives a credit card number over the telephone to the call receiver (a live telephone operator and often a volunteer supporter of the PBS or other cause).



The discussion of such fund-raising activities by the examiner, however, fails to disclose or suggest any aspect of the claimed invention wherein a payment (donation) to a receiving party is caused *automatically* simply by the act of making of the phone call, wherein the price of the phone call is charged to the originator of the call and consists of a part representing the operational costs of the data processing entity and another part representing an action-specific amount to be forwarded by the data processing entity to the receiver of the incoming call.

Further, the examiner's discussion of "businesses or retailers (providers) such as Giant Food" that encourage "their customers to support their stores by donating a certain percentage of the customers transaction amount to schools or non-profit organizations previously selected," or "a merchant or service provider, such as a telephone service provider or telecommunication provider, [sets] up a selling price for a product or service, such as a phone call, by adding purchase price and overhead cost to a desired profit margin," ignores an important aspect of the present invention since in the examples cited by the examiner, the incentive of the donation lies in the hands of the business (such as Giant Food), or the merchant, or the service provider or telecommunication provider, and NOT in the hands of the call originator or the caller, as is the case with Applicant's claimed invention.

Ziarno discloses that a "Fund-raiser's computer 103, 405 *sends a fund-raising request* or solicitation to prospective contributors, e.g. cardholder contributors, on a plurality of networks 301, 303, 305, 307, 309, 401 and receives responsive cardholder contributor *card information* and, optionally, numerical contribution amount information therefrom." (Ziarno; [0043]) (emphasis added).

In the example of a Public Broadcasting Station (PBS) fund-raising activity, as explained by the examiner, allows viewers to use their telephones to respond to solicitations by using their telephones to donate. However, the examiner has not provided any evidence or discussion as to how such donations are paid to the PBS.

Referring to Ziarno, which discusses such fund raisers, "A contributor is requested to make a pledge, and then later to honor the pledge by payment of the amount pledged. A

problem with this type of fund-raising is that a number of pledges do not get honored.” (*Ziarno*; [0002]). Accordingly, based on the teachings of *Ziarno*, such donations are paid later, such as by mailing a check to the fund-raising organization. (see *Ziarno*; [0004]).

Therefore, even combining the telephone fund raising of the examiner’s PBS example with the teachings of *Ziarno*, there is no teaching or suggestion of automatically causing a transfer of funds to a party receiving a call, while at the same time generating a charge to the caller that reflects the donation amount along with a service cost of the call.

Quite differently, *Ziarno* teaches that “contributions, including contributor cardholder card, e.g. credit card or debit card information and numerical contribution amount information, optionally encrypted cardholder account information, cyber-cash account information, cybercash, or ecash (electronic cash) (referred to herein as “contribution information”), are also returned [by the contributor] to fund-raiser’s computer 107, 405, a plurality of fund-raiser’s computers, a card account processor computer 1031 (FIG. 3), a bank computer, or the like within a matter of seconds.” (*Ziarno*; [0034]).

In other words, according to *Ziarno* the donator provides payment information directly to the recipient. This is different from the present invention, wherein funds are provided by the data processing entity through whose services the telephone connection is made, while in a separate transaction the caller is charged.

Therefore, even replacing *Ziarno*’s Internet infrastructure and communication with the telephone connection of the claimed invention, a different result is reached. Therefore, modification of *Ziarno* simply in view of the telephone based fundraisers noted by the examiner and discussed in *Ziarno* would not result in the presently claimed invention.

Accordingly, it is respectfully submitted that, for at least these reasons, *Ziarno* along with the examiner’s “Official Notice” fails to provide a basis for a prima facie case of obviousness of claim 1. Therefore, it is respectfully submitted that claim 1, and claims 2, 3, and 18 which depend from claim 1, are allowable over the cited references, and withdrawal of the rejection is requested.

Application No.: 09/824,105  
Examiner: J. Janvier  
Art Unit: 9304

Conclusion

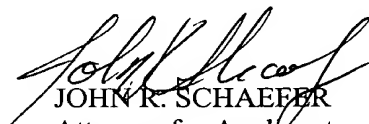
In view of the amendments to the claims, and in further view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is requested that claims 1-3 and 18 be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the Applicant's attorney, the Examiner is invited to contact the undersigned at the numbers shown.

BACON & THOMAS, PLLC  
625 Slaters Lane, Fourth Floor  
Alexandria, Virginia 22314-1176  
Phone: (703) 683-0500

Date: 9/20/07

Respectfully submitted,

  
JOHN R. SCHAEFFER  
Attorney for Applicant  
Registration No. 47,921